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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,796	08/30/2000	John Underwood	730301-2017	2074
20999 7590 02/14/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER OSMAN, RAMY M	
			ART UNIT 2157	PAPER NUMBER
			MAIL DATE 02/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/651,796

Applicant(s)

UNDERWOOD ET AL.

Examiner

RAMY M. OSMAN

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This communication is responsive to amendment filed on November 19, 2007, where applicant amended claims 1,12,13,24-28. Claims 1-28 are pending.

### ***Drawings***

2. The replacement drawings filed on 10/30/2000 are finally acknowledged and are acceptable.

### ***Response to Amendments***

3. Applicant's amendments filed 11/19/2007 have been fully considered but are not persuasive.
4. Applicant argues that neither Cohen, Bernando nor Burge teach the amended limitation of "remotely executing an application that may or may not retrieve web site data such that whether content is retrieved is a function of the remotely executed application".

***In reply***, after further search and consideration it is found that this new limitation is indeed taught by Cohen. Cohen discloses that a store builder wizard (SBW) resides on an ISP computer and is remotely executed by a merchant computer (column 6 lines 22-26). Cohen further discloses that the function of the SBW is to gather input data from merchants via step by step instructions/questions presented to the merchant (column 7 lines 51-59). A merchant inherently may or may not input data into any of the presented instructions/questions (column 8 lines 6-20).

***Claim Rejections - 35 USC § 101***

5. Claims 25-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a system comprising “means for...”. According to Applicants disclosure, page 16 lines 15-16 mentions a “Definer software” that is used for generating a website. It is possible that the “means for” within the claim is referring solely to the “Definer software” within the disclosure. If this is the case, then the claims are directed to a program itself and not to a process occurring as a result of executing the program. The claims are not directed to a machine programmed to operate in accordance with the program, nor to a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. The claims are therefore nonstatutory.

6. Claims 27-28 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite “a set of computer program instructions” for generating a website, and comprising a number of instructions. A claim of instructions is directed to claiming a program per se and is not directed to a process occurring as a result of executing the program on an actual physical machine. For a claim like this to be statutory, an actual hardware device is required, where the device is programmed to operate in accordance with the program in order to realize the functionality of that program. These claims do meet this criterion and are therefore deemed non-statutory.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-10,12-22 and 24-28 rejected under 35 U.S.C. 102(e) as being anticipated by Cohen (U.S. Patent No. 6,263,352).**

9. In reference to claims 1 and 13, Cohen respectively teaches a method and corresponding system, comprising the steps of:

receiving first data entry including selection of an industry type (column 7 lines 53-55 & 61-63, Cohen discloses entering merchant information);

presenting one or more questions based at least in part on the selected industry type (column 7 lines 53-60, Cohen discloses presenting step by step instructions and questions to merchants);

receiving a second data entry in response to the one or more questions (column 7 lines 58-64, Cohen discloses various questions that each require data entry);

determining one or more characteristics for each of one or more web site dimensions in accordance with the first and second data entries (column 7 lines 50-52, Cohen discloses utilizing input data to generate a customized web site);

generating a description, including a structure, of the web site based upon the one or more determined characteristics for each of the one or more web site dimensions (column 7 line

Art Unit: 2157

65 - column 8 line 30, Cohen discloses gathering merchant and website information to generate a website);

retrieving web site data including pre-created industry content from an external data source in accordance with the generated description of the web site (column 8 lines 31-40, Cohen discloses active server templates that are generic for a variety of merchants);

generating one or more pages of the web site based upon the description of the web site and the retrieved web site data (column 7 lines 50-52);

remotely executing an application that may or may not retrieve web site data such that whether content is retrieved is a function of the remotely executed application (column 6 lines 22-26 and column 7 lines 51-59, Cohen discloses a merchant remotely executing an SBW application that may gather data input by a merchant, or may not gather data if the merchant has not input data);

presenting the generated web site (column 4 lines 22-25 and column 6 lines 31-41, Cohen discloses presenting the web site to customers).

10. In reference to claims 2 and 14, Cohen respectively teaches the method and system as claimed in claims 1 and 13, wherein the external data source is a web site (c column 8 lines 31-40 and Figure 6, Cohen discloses a Meta Site).

11. In reference to claims 3 and 15, Cohen respectively teaches the method and system as claimed in claims 1 and 13, wherein the description defines a format of the pre-created industry content (column 8 lines 31-40).

Art Unit: 2157

12. In reference to claims 4 and 16, Cohen respectively teaches the method and system as claimed in claims 3 and 15, wherein the format of the pre-created industry content includes a look and feel of the dynamic content data (column 8 lines 31-40).

13. In reference to claims 5 and 17, Cohen respectively teaches the method and system as claimed in claims 3 and 15, wherein the format of the pre-created industry content defined by the generated description is different from a format of the pre-created industry content as retrieved from the external data source (column 7 line 50 – column 8 line 10 and column 8 lines 31-40).

14. In reference to claims 6 and 18, Cohen respectively teaches the method and system as claimed in claims 3 and 15, wherein the format of the pre-created industry content matches a format of the web site (column 7 line 50 – column 8 line 10 and column 8 lines 31-40).

15. In reference to claims 7 and 19, Cohen respectively teaches the method and system as claimed in claims 6 and 18, wherein the format of the web site is defined by at least one of the characteristics of at least one of the web site dimensions (column 7 lines 51-64).

16. In reference to claims 8 and 20, Cohen respectively teaches the method and system as claimed in claims 1 and 13, further comprising the step of storing the description of the web site (column 8 lines 41-48 and Figure 6 #120).

17. In reference to claims 9 and 21, Cohen respectively teaches the method and system as claimed in claims 1 and 13, wherein the data entry includes one or more user preferences (column 8 lines 6-20).

18. In reference to claims 10 and 22, Cohen respectively teaches the method and system as claimed in claims 1 and 13, wherein the data entry includes one or more user profiles (column 8 lines 21-22).

Art Unit: 2157

19. In reference to claims 12 and 24, Cohen respectively teaches a method and corresponding system, respectively comprising the steps of:

receiving first data entry, at least a portion of the first data entry designating an external data source of dynamic content data (column 7 lines 53-55 & 61-63, Cohen discloses entering merchant information where a merchant is a data source);

presenting one or more questions based at least in part on the first data entry (column 7 lines 53-60, Cohen discloses presenting step by step instructions and questions to merchants);

receiving a second data entry in response to the one or more questions (column 7 lines 58-64, Cohen discloses various questions that each require data entry);

determining one or more characteristics for each of one or more web site dimensions in accordance with the first and second data entries (column 7 lines 50-52, Cohen discloses utilizing input data to generate a customized web site);

defining at least one of the characteristics of at least one of the web site dimensions based upon the designated external data source (column 7 lines 50-52, Cohen discloses utilizing input data to generate a customized web site);

generating a description, including a structure, of the web site based upon the one or more determined characteristics for each of the one or more web site dimensions, the description including a description of the designated external data source (column 7 line 65 - column 8 line 30, Cohen discloses gathering merchant and website information to generate a website);

retrieving web site data including pre-created industry content from an external data source in accordance with the generated description of the web site (column 8 lines 31-40, Cohen discloses active server templates that are generic for a variety of merchants);



Art Unit: 2157

generating one or more pages of the web site based upon the description of the web site and the retrieved web site data (column 7 lines 50-52);

remotely executing an application that may or may not retrieve web site data such that whether content is retrieved is a function of the remotely executed application (column 6 lines 22-26 and column 7 lines 51-59, Cohen discloses a merchant remotely executing an SBW application that may gather data input by a merchant, or may not gather data if the merchant has not input data);

presenting the generated web site (column 4 lines 22-25 and column 6 lines 31-41, Cohen discloses presenting the web site to customers).

20. In reference to claims 25 and 27, these are respective system and computer program instruction claims that correspond to the method claim 1. Therefore, claims 25 and 27 are rejected based upon the same rationale as given for claim 1 above.

21. In reference to claims 26 and 28, these are respective system and computer program instruction claims that correspond to the method claim 12. Therefore, claims 26 and 28 are rejected based upon the same rationale as given for claim 12 above.

### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2157

**23. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (U.S. Patent No. 6,263,352) in view of Burge et al. (U.S. Patent No. 6,014,638).**

Cohen teaches the method of claims 1 and 13 above. Cohen fails to teach wherein the data entry includes one or more navigation histories. However, Burge teaches using navigation history to customize the presentation of information in accordance with a users needs and preferences (column 3, lines 45-55).

It would have been obvious to one having ordinary skill in the art to modify Cohen by enabling the data entry to comprise navigation histories as per the teachings of Burge so as to customize the presentation of information in accordance with a users needs and preferences.

### ***Conclusion***

24. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

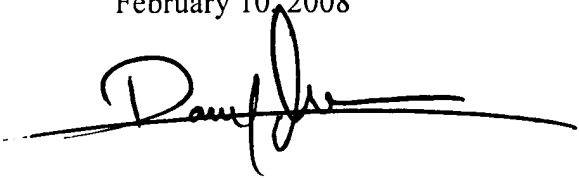
Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

Art Unit: 2157

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RMO  
February 10, 2008

A handwritten signature in black ink, appearing to read 'RMO', with a long horizontal line extending to the right.